<u>REMARKS/ARGUMENTS</u>

Claims 1-12, 16, 17, 19-30, 34-45, 49 and 50 are pending in the present application. Claims 13-15, 18, 31-33 and 46-48 have been canceled; Claims 1, 2, 5, 9, 12, 16, 17, 19, 20, 23, 27, 30, 34, 35, 38, 42 and 45 have been amended; and Claims 49 and 50 have been added; herewith. Reconsideration of the pending claims is respectfully requested.

I.   <u>35 U.S.C. § 112, Second Paragraph</u>

The Examiner rejected Claims 1, 12, 16, 19, 30, 34 and 45 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

In rejecting Claims 1, 12, 16, 19, 30, 34 and 45, the Examiner states that the format for use with a financial program is indefinite since such formats may be developed in the future and it would be improper for the scope of the claim to change over time. While Applicants deny such assertion, as the scope of the claim would not change but instead could cover after-arising, equivalent technology (claims are routinely found to properly cover after-arising technology[1]), Applicants have amended such claims to eliminate such objectionable language in order that this case can expeditiously pass to issuance.

Therefore the rejection of Claims 1, 12, 16, 19, 30, 34 and 45 under 35 U.S.C. § 112, second paragraph has been overcome.

II.   <u>35 U.S.C. § 102, Anticipation</u>

The Examiner rejected Claims 9, 11, 12, 17, 27, 29, 30, 42, 44, and 45 under 35 U.S.C. § 102 as being anticipated by Ramster, "End of the Paper Chase." Banking Technology, v14, n6, p32-36, Jul/Aug 1997. This rejection is respectfully traversed.

Claim 1 is directed a methodology where a check is *received* from a user at an automated teller machine. Claim 9 is directed to a methodology where a check is *issued* at the automated teller machine. In rejecting Claim 9, the Examiner states that the cited reference teaches steps of (i) receiving a check from a user at an ATM, (ii) scanning the check to generate an image, (iii) performing a transaction involving the check, and (iv) transmitting the image to the user in a manageable disk format. These are all steps that are recited in Claim 1, but these are not steps that are recited in Claim 9. Notably absent is any assertion that the cited reference teaches any step of *issuing a check* at the automated teller machine. In any event, Applicants have amended Claim 9 (and similarly for Claims 17, 27 and 42) to further

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[1] A primary justification for the doctrine of equivalents is to accommodate after-arising technology. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 62 USPQ 2d 1705 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

differentiate the claimed subject matter from the teachings of the cited reference, such that this case can expeditiously pass to issuance. It is urged that the cited reference does not provide any teaching of a method or system that *creates/generates* new checks at an automated teller machine (Specification page 18, line 7 – page 19, line 5 and Figure 10; page 23, line 28 – page 24, line 31 and Figure 15). Rather, the cited reference only describes an ability to process *pre-existing* checks. Therefore, as every element of the claimed invention is not identically shown in a single reference, it is urged that Claim 9 (and similarly for Claims 11, 12, 17, 27, 29, 30, 42, 44 and 45) is not anticipated by the cited reference.

Therefore, the rejection of Claims 9, 11, 12, 17, 27, 29, 30, 42, 44 and 45 under 35 U.S.C. § 102 has been overcome.

III.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-4, 10, 16, 19-22, 28, 34-37 and 43 under 35 U.S.C. § 103 as being unpatentable over Ramster, "End of the Paper Chase." Banking Technology, v14, n6, p32-36, Jul/Aug 1997, in view of Tobita, U.S. Patent No. 6,782,419. This rejection is respectfully traversed.

Claim 1 has been amended in accordance with the preferred embodiment described in the Specification at, for example, page 15, lines 6 – 29 and page 22, line 24 – page 23, line 27. As can be seen, a check is scanned to form an image, and the image is transmitted to a financial institution for processing (performing a transaction), with the results of such processing being returned to the ATM and transmitted to a mobile device. These transaction results are transmitted to the mobile device *in addition to* the image being transmitted to the mobile device. None of the cited references teach or suggest transmitting, to a mobile device, both (i) an image scanned by an ATM as well as (ii) transaction results from a separate data processing system. Rather, the cited Ramster reference merely contemplates transmitting scanned information *to* a financial institution and the cited Tobita reference merely contemplates transmitting images to a mobile phone. Thus, the amendment to Claim 1 has overcome the present 35 U.S.C. § 103 rejection.

The features of Claim 1 advantageously provide an ability for a user to deposit a check at an automated teller machine and be able to process the results of such deposit (transaction results) by their financial program (Claim 2) – either in their PDA (Claim 3) or other computing device (Claim 4). None of the cited references teach or suggest such closed-loop system whereby a user can contemporaneously process the results of an ATM check deposit by their end-user financial program (Specification page 2, lines 16-24). These advantages are made possible by sending two different things (image, transaction result) to a mobile device, where *these two different things resulting from two different processes/elements* (scanning by ATM, performing a transaction at a financial institute data processing system).

Applicants initially traverse the rejection of Claims 2-4 for reasons given above with respect to Claim 1 (of which Claims 2-4 depend upon).

Further with respect to Claim 2, none of the cited references teach or suggest the claimed feature of importing the image into a *financial* program. In rejecting Claim 2, the Examiner cites Ramster page 4, paragraph 9 as teaching such claimed feature. Applicants urge that there, Ramster merely states that an image can be sent to an email inbox, fax number, or linked into applications such as a word processor by use of OCR techniques. There is no teaching or suggestion that these images are imported into a financial program. In any event, Applicants have amended Claim 2 to further clarify this distinction. Thus, it is further urged that Claim 2 is not obvious in view of the cited references.

Applicants traverse the rejection of Claim 10 (and similarly for Claims 28 and 43) for reasons given above with respect to independent Claim 9.

Applicants traverse the rejection of Claims 16, 19-22 and 34-37 for similar reasons to those given above with respect to Claims 1-4.

Therefore, the rejection of Claims 1-4, 10, 16, 19-22, 28, 34-37 and 43 under 35 U.S.C. § 103 has been overcome.

IV.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 5, 6, 23, 24, 38 and 39 under 35 U.S.C. § 103 as being unpatentable over Ramster and Tobita and further in view of Goldsmith, U.S. Patent No. 6,064,990. This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 5 and 6 (and similarly for Claims 23, 24, 38 and 39) for reasons given above with respect to Claim 1.

Further with respect to Claims 5 and 6 (and similarly for Claims 23, 24, 38 and 39), Applicants have amended Claim 5 to further clarify and differentiate the features recited therein from the teachings of the cited references. It is urged that none of the cited references teach or otherwise suggest sending an alert to *multiple parties* associated with an account which is updated based upon a transaction result.

Therefore, the rejection of Claims 5, 6, 23, 24, 38 and 39 under 35 U.S.C. § 103 has been overcome.

V.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 7, 8, 25, 26, 40 and 41 under 35 U.S.C. § 103 as being unpatentable over Ramster and Tobita and further in view of Stinson, U.S. Patent No. 6,856,965. This rejection is respectfully traversed for reasons given above with respect to Claim 1.

Therefore, the rejection of Claims 7, 8, 25, 26, 40 and 41 under 35 U.S.C. § 103 has been overcome.

VI. New Claims

Claims 49 and 50 have been added herewith, in accordance with the description provided in the Specification at page 15, lines 17-27; page 20, lines 5-11. Examination of such claims is respectfully requested.

VII. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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